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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,531	05/31/2000	Shai Mohaban	50325-0085	6019
29989	7590	11/28/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP			FERRIS, DERRICK W	
2055 GATEWAY PLACE			ART UNIT	
SUITE 550			PAPER NUMBER	
SAN JOSE, CA 95110			2663	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/586,531	Applicant(s) MOHABAN ET AL.	
	Examiner  Derrick W. Ferris	Art Unit 2663	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

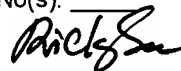
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: see attached sheet(s).


RICKY Q. NGO
SUPERVISORY PATENT EXAMINER
 11/22/05

In summary, applicant argues that two of the named inventors (Silvano Gai and Dinesh Dutt) are co-authors of the Gai reference where the Gai reference was applied as the primary reference in an obviousness rejection rejecting all the claims. As such, applicant argues that the rejection should be withdrawn based on at least the co-authorship. As such, please find below reasons why the Office does not accept applicant's affidavit(s) filed 11/8/2005 and thus does not recognize Silvano Gai and Dinesh Dutt as inventors to the claimed subject matter.

Oath or Declaration filed 3/11/2004

At first issue with the affidavit filed 11/8/2005 is applicant's Oath or Declaration filed 3/11/2004 which is relied upon in the affidavit. In summary, applicant added the two co-authors of the Gai reference in an Oath or Declaration filed 3/11/2004. The examiner acknowledged the receipt of the Oath or Declaration filed 3/11/2004 in the Final rejection mailed 3/11/2004. However, upon careful further review, applicant's statement of inventorship does not comply with all the criteria set in CFR 1.48 (a)(5). In particular, missing is the written consent of the assignee. Specifically, in order to overcome this issue, all criteria must be met from the assignee as mentioned in MPEP 201.03. Thus the Oath or Declaration filed 3/11/2004 is found to be defective and thus applicant's 37 CFR 1.132 affidavit filed 11/8/2005 is not accepted based in-part on the defective declaration filed 3/11/2004.

Attorney's Declaration

The examiner acknowledges that the attorney at paragraph 3, page 1 of their Declaration states that the original inventors (Shai Mohahan and Itzhak Parnafes) "expressly refused to sign documents concerning other patent applications" and the original inventors where "most likely unavailable" as mentioned by applicant's Remarks on page 3.

Co-author's (Silvano Gai and Dinesh Dutt) Declaration(s)

The examiner acknowledges the co-author's declaration(s).

At second and third issue with the affidavit filed 11/8/2005 is the declaration filed by the applicant's attorney. In particular, with respect to the declaration as a whole and in particular at paragraphs 4 and 5 on page 2 it is not clear who the term "we" refers to. In addition, insufficient evidence was provided in paragraph 4 on page 2 since it unclear what applicant is trying to prove and to what extent applicant is trying to prove something. Thus the examiner is requesting that applicant clarify who "we" refers to and further clarify the extent (i.e., factual evidence) of each person's contribution (i.e., Shai Mohahan, Itzhak Parnafes, Silvano Gai, Dinesh Dutt, Nitsan Elfassy and Yoram Bernet) mentioned in paragraph 4. Similar reasoning also applies to paragraph 5 on page 2. It is unclear who "we" and "our" refers to in paragraph 5. It is further unclear what aspects of the invention are considered their own work and furthermore how Silvano Gai and Dinesh Dutt's work relates to Shai Mohahan and Itzhak Parnafes work (i.e., is we the original inventors or all the inventors). It is further unclear what contribution was provided by Nitsan Elfassy and Yoram Bernet. The evidence provided by applicant suggests that these two people should also be named as inventors. Furthermore, evidence shows Yoram Bernet provided contributions to the invention as shown in U.S. Patent Application 2004/0022191 A1 mentioned in the current rejection. As such, insufficient evidence was provided by applicant in the co-author's declaration to make any determination.

Original Inventors (Shai Mohahan and Itzhak Parnafes) Declaration(s)

The declarations sent to Shai Mohahan and Itzhak Parnafes states that the co-author's (Silvano Gai and Dinesh Dutt) have explained to the attorney that the original inventors (Shai Mohahan and Itzhak Parnafes) (i.e., you) conceived of the invention prior to the publication of Exhibit A, and that the purpose of publicizing the reference of Exhibit A was to present the original inventors (Shai Mohahan and Itzhak Parnafes) (i.e., your) invention to the Internet community. Thus, at forth issue, the evidence provided suggests that the co-authors did not invent anything but merely published the work of the original inventors (Shai Mohahan and Itzhak Parnafes), see the disclosure at the top of page 2.

Furthermore, applicant's remarks point to MPEP 715.04 with respect to the declaration and in particular, if a joint inventor is deceased, refuses to sign or is otherwise unavailable then, the signatures of the other remaining are sufficient to accept a declaration under 37 CFR 1.132, see applicant's remarks in second full paragraph on page 3. However, at issue is the sentence following the above cited sentence in the MPEP which states the following: "However, the affidavit, or declaration, even though signed by fewer than all the inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935)". Again, applicant has yet to provide factual evidence showing completion of the invention by all of the joint inventors of the subject matter and in particular factual evidence by Silvano Gai, Dinesh Dutt, Nitsan Elfassy and Yoram Bernet.

Timeliness

At fifth issue is timeliness for filing applicant's 37 CFR 1.132 affidavit in view of MPEP 716.01(a). Applicant argues in their response that the affidavit was not filed since applicant believed they could traverse the rejection on the merits, see applicant's remarks in third full paragraph on page 3. The Office cannot determine timeliness until applicant clarifies why the above issue wasn't raised or noted in the either the 37 CFR 1.132 affidavit filed 3/11/04 or applicant's remarks filed 3/11/04. In particular, the Gai reference was first applied in the non-final Office action mailed 9/22/03. Based on the above non-final rejection, applicant filed a change of inventorship under rule 37 CFR 1.48 which included the 37 CFR 1.132 affidavit and applicant's remarks filed 3/11/04. Why didn't applicant raise the above issue then since it is applicant's duty to be fully responsive under MPEP 714.02. Please respond to the fifth issue so the examiner can determine whether the affidavit was timely filed since as it stands not enough evidence was provided in order to support applicant's above statement of timeliness.